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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/018,568	08/01/2001	Yoshinobu Okuno	2001_0977	4882

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EXAMINER

NAVARRO, ALBERT MARK

ART UNIT

PAPER NUMBER

1645

DATE MAILED: 08/20/2003

12 ✓

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/918,568

Applicant(s)

Okuno et al

Examiner

Mark Navarro

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-30 is/are pending in the application.
- 4a) Of the above, claim(s) 24-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/004,422.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6 6) ☐ Other:

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DETAILED ACTION

Election/Restriction

1. Applicant's election of Group I, claims 20-23, in Paper No. 11, received July 24, 2003 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Specification

2. The disclosure is objected to because of the following informalities:

Applicants are reminded that all claims of priority must be recited in the first line of the specification. Applicants attention is particularly drawn to the Bib Data Sheet which recites only 09/004,422 and 08/443,862 as well as foreign priority claims as far back as 1992. However, these foreign priority claims can only be afforded when claiming priority to 08/054,016.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

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3. Claims 20-23 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a written description rejection.

Claims 20-23 recite an isolated gene which codes for a polypeptide having an antigenicity which is substantially the same as that of the stem region of hemagglutinin molecule of human influenza A virus, as well as DNA sequences of SEQ ID NO: 46, 49, and 57.

The specification and claims do not indicate what distinguishing attributes are shared by the members of the genus. Thus, the scope of the claims includes numerous structural variants, and the genus is highly variant because a significant number of structural differences between genus members is permitted. Since the disclosure fails to describe the common attributes or characteristics that identify members of the genus, and because the genus is highly variant, SEQ ID NO: 46, 49 and 57 alone are insufficient to describe the genus. Thus, Applicant's have not described a function which is shared by SEQ ID NO: 46, 49 and 57 which would adequately describe the genus. One of skill in the art would reasonably conclude that the disclosure fails to provide a representative number of species to describe the genus. Thus, applicant was not in possession of the claimed genus. It is further noted that SEQ ID NO: 46, 49 and 57 are not full length open reading frames, given that the classical start and/or stop codons are missing. Given that the function of the non-full length protein is not set forth, the written description of the

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instant application is supportive of only a DNA sequence consisting of SEQ ID NO: 46, 49 and 57, since additional nucleotides 5' or 3' will encode proteins with additional amino acids on the N-terminus or C-terminus and will have a profound impact on the activity of the protein.

Adequate written description requires more than a mere statement that it is part of the invention and a reference to a potential method of isolating it. The protein itself is required. See *Fiers v. Revel*, 25 USPQ2d 1601 at 1606 (CAFC 1993) and *Amgen Inc. V. Chugai Pharmaceutical Co. Lts.*, 18 USPQ2d 1016.

Applicants are directed to the Revised Interim Guidelines for the Examination of Patent Applications Under the 35 U.S.C. 112, 1 "Written Description" Requirement, Federal Register, Vol. 64, No. 244, pages 71427-71440, Tuesday December 21, 1999.

4. Claims 20-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are vague and indefinite in the recitation of "substantially the same as." For instance at what point is antigenicity "substantially the same as" e.g., 90%, 70%, 50%, etc. Furthermore, what property is being measured, 3-D structure, antigenic cross-reactivity, etc.? Without a clear definition as to the metes and bounds of the term "substantially the same as" one of skill in the art would be unable to determine the metes and bounds of the claimed invention.

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 20 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by McCauley et al.

The claims are directed to an isolated gene which codes for a polypeptide having an antigenicity which is substantially the same as that of the stem region of hemagglutinin molecule of human influenza A virus and lacking a globular head region of hemagglutinin molecule of human influenza A virus.

McCauley et al (FEBS Letters Vol. 108 (2) pp 422-426, 1979) disclose of the influenza virus haemagglutinin signal sequence. (See abstract and pages 424-425).

In view that the DNA molecule disclosed by McCauley et al is "substantially the same" as the gene as recited in the claims, the disclosure of McCauley et al is deemed to anticipate the claimed invention.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Navarro, whose telephone number is (703) 306-3225. The examiner can be reached on Monday - Thursday from 8:00 AM - 6:00 PM. The examiner can be reached on alternate Fridays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Lynette Smith can be reached at (703) 308-3909.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Group 1645 by facsimile transmission. Papers should be faxed to Group 1645 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the official Gazette 1096 OG 30 (November 15, 1989). The CMI Fax Center number is (703) 308-4242.


Mark Navarro

Primary Examiner

August 18, 2003